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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,939	06/08/2001	Robert J. Nighan	SPLT-P01-003	1437
28120	7590	01/18/2006	EXAMINER	
FISH & NEAVE IP GROUP ROPES & GRAY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 01/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/877,939	NIGHAN, ROBERT J.	
	Examiner Martin A. Gottschalk	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 June 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-22 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03/2001</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 have been examined.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

A. In the present case, the abstract is longer than 150 words and repeats information given in the title.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-8, 11-18, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs in view of Report on Home Banking & Financial Services ("A Cool Response to Insurance Guarding Online Fraud." Report on Home Banking & Financial Services. Chicago: Apr 22, 1998. Vol. 3, Iss. 14; pgs. 1-2; hereinafter RHB.)

A. As per claim 1, Luchs discloses a method of providing insurance against loss (Luchs: Abstract)

receiving a requirement for a policy structure for a master insurance policy that provides coverage for loss relating to use by the consumer (Luchs: Fig 2F, item 178; col 18,Ins 1-2)

defining a plurality of account categories having an associated risk of loss for the consumer (Luchs: col 8, Ins 22-25, see also chart bottom right of same page)

ascertaining at least one of the defined account categories that corresponds to the requirement for the policy structure for the master insurance policy (Luchs col 18, Ins 11-16); and

Luchs fails to disclose where the policy is for loss related to an unauthorized online financial transaction for which the consumer would normally have responsibility under applicable banking regulations.

However, this feature is well known in the art as evidenced by RHB.

RHB discloses an insurance policy "...designed to protect consumers against liability beyond what is covered by Regulation E of the Electronic Funds transfer Act..." (RHB: sixth paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of RHB within the teachings of Luchs. Luchs suggests home insurance as a risk class for the invention, and RHB suggests combining online financial transaction with home owners insurance (RHB: ninth paragraph) with the motivation of differentiating a product offering from competitors (RHB: tenth paragraph).

B. As per claims 2 and 3, Luchs fails to disclose the method of claim 1, wherein receiving the requirement further comprises

(claim 2) receiving the requirement from a service provider of at least one

(claim 3) receiving the requirement for the policy structure for the master insurance policy that provides coverage for loss relating to use by the consumer of at least one

online financial transaction service selected from a group of online financial transaction services consisting of

an online banking service,

an online bill management service,

an account aggregation service, and

an online person to person payment service.

However, these features are well known in the art as evidenced by the teachings of RHB who discloses an insurance policy for an online banking service (RHB: sixth paragraph).

The motivation to combine the teachings of Luchs and RHB are as provided above for claim 1 and is incorporated herein.

C. As per claim 4, Luchs fails to disclose the method of claim 1, wherein defining the account categories further comprises

defining account categories consisting of at least one of

a banking account of the consumer capable of online transactions,

an account of the consumer to which an online funds transfer service provider is given access by the consumer as part of a bill management service,

accounts of the consumer to which the service provider is given access by the account-owning consumer as part of an account aggregation service, and

an account of the consumer from which an online payment service provider is authorized by the consumer to make payments.

However, this feature is well known in the art as evidenced by the teachings of RHB.

RHB teaches a policy covering a banking account of the consumer capable of online transactions (RHB: fifth and sixth paragraphs).

The motivation to combine the teachings of Luchs and RHB are as provided above for claim 1 and is incorporated herein.

D. As per claims 5-7 Luchs fails to disclose the method of claim 1, wherein defining the account categories further comprises

defining account categories having the associated risk of loss for the consumer for which loss the consumer would normally have responsibility that is imposed in

- (claim 5) a plurality of tiers
- (claim 6) three tiers
- (claim 7) a \$50 tier, a \$500 tier, and an unlimited tier

of consumer liability under applicable banking regulations.

However, this feature is well known in the art as evidenced by the teachings of RHB.

RHB teaches a \$50, \$500, and unlimited tier for which the consumer normally has responsibility under Regulation E (RHB: sixth paragraph).

The motivation to combine the teachings of Luchs and RHB are as provided above for claim 1 and is incorporated herein.

E. As per claim 8, Luchs fails to disclose the method of claim 1, wherein ascertaining the at least one defined account category further comprises

ascertaining at least one

defined account category selected from a group of account categories consisting of

a banking account of the consumer capable of online transactions,

an account of the consumer to which an online funds transfer service provider is given access by the consumer as part of a bill management service,

accounts of the consumer to which the service provider is given access by the account-owning consumer as part of an account aggregation service, and an

account of the consumer from which an online payment service provider is authorized by the consumer to make payments.

However, this feature is well known in the art as evidenced by the teachings of RHB.

RHB teaches a policy covering a banking account of the consumer capable of online transactions (RHB: fifth and sixth paragraphs).

The motivation to combine the teachings of Luchs and RHB are as provided above for claim 1 and is incorporated herein.

F. As per claims 11-18 they are system claims which repeat the same limitations of claims 1-8, the corresponding method claims, as a collection of elements as opposed to

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a series of process steps. Since the collective teachings of Luchs and RHB disclose the underlying process steps that constitute the methods of claims 1-8 it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 11-18 are rejected for the same reasons and motivations given above for claims 1-8.

G. As per claims 21 and 22, the steps contained in the claims correspond to the steps found in claims 1-8. The steps of claims 21 and 22 are thus rejected for the same reasons and motivations provided for the corresponding steps found in claims 1-8.

6. Claims 9, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs as applied to claim 1 above, and further in view of National Underwriter ("PayMyBills.com Offers SafeWeb." National Underwriter. Erlanger: Aug 16, 1999. Vol. 103, Iss. 33; pg. 14; hereinafter NU).

A. As per claims 9 and 10, Luchs fails to disclose the method of claim 1, wherein

inserting online financial transaction coverage further comprises

inserting at least one

online financial transaction coverage selected from a group of online financial transaction coverages consisting of

(claim 9) coverage for loss resulting from unauthorized transactions in the account for which the consumer would normally have liability under applicable banking regulations,

coverage for expenses incurred by the consumer as a result of a covered unauthorized transaction in the account for which the consumer would normally have liability under applicable banking regulations, and

coverage for expense incurred by the online consumer as the direct result of an identity fraud.

(claim 10) providing coverage to the consumer for a merchant-assessed returned check fee on an overdrawn account of the consumer as a result of an unauthorized transaction covered by the master insurance policy.

However, this feature is well known in the art as evidenced by the teachings of NU.

NU teaches a policy covering expenses incurred for merchant-assessed returned check fee on an overdrawn account of the consumer as a result of an unauthorized

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transaction covered by the master insurance policy, as well as any loss of interest income that results from a covered unauthorized transaction (NU: sixth paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of NU into the system of Luchs with the motivation of increasing a customer's sense of security regarding an online transaction (NU: fourth paragraph).

B. As per claims 19-20 they are system claims which repeat the same limitations of claims 9-10, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the collective teachings of Luchs and NU disclose the underlying process steps that constitute the methods of claims 9-10 it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 19-20 are rejected for the same reasons and motivations given above for claims 9-10.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art disclose a variety of methods and systems for assessing insurable risks, providing a quote for a premium, and generating a policy for the risk (US Pat#s 6,456,979; 4,567,359; 5,655,085; 5,523,942; 6,026,364).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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09/17/2005

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SUPERVISORY PATENT EXAMINER